

- - REMARKS - -

Applicant notes that this is the fourth rejection issued by the Office, and despite an appeal, the Board has yet to have an opportunity to review the examination to date and no claim has been amended. New claim 18 has been added, support for which is found on page 4, lines 5-26 of the specification. The prior art does not disclose, teach or suggest each and every element of claim 18, and therefore claim 18 is patentable.

Claims 1-17 were rejected under 35 U.S.C. §103(a) as unpatentable over Vidyanand in view of Mukaiyama

The §103(a) rejections of claims 1-17 as unpatentable over Vidyanand in view of Mukaiyama is traversed. In order to sustain the rejection, each and every element of the claimed invention must be taught or suggested by the reference alone or in combination. Since these references do not teach or suggest each and every element, the rejection should be withdrawn.

The Examiner's construction of the claims is untenable, and evidences the failure of the references to teach or suggest the claimed elements. Specifically, the Examiner's comparison of the claimed "first and second companies" with first and second computers is bizarre at best, and to then compare the claimed "storing transmission capabilities" with sets of printing preferences compounds the error. The Examiner is gently reminded that anticipation requires disclosure of the claimed elements, in as great detail as claimed. Furthermore, whether Mukaiyama teaches, or not, that "companies uses computers, printers, fax machines to maintain the conduct of business" is utterly irrelevant. In fact, such a teaching is perhaps best made, not with a reference, but with official notice. Regardless, a finding of obviousness cannot be supported here.

At a minimum, Vidyanand in view of Mukaiyama fails to teach or suggest, in as great detail as claimed:

“receiving transmission capability from a first company and a second company”;

“storing transmission capabilities”;

“receiving a request from one of the first and second companies to do business with the other company”; and

“determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities” as substantially claimed in independent claims 1, 8, and 15. Instead, Vidyannand discloses, at most, a reusable and transferrable printer drive preference system.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 18, 148 USPQ at 467. Here, the Examiner’s analysis ignores the numerous and fundamental differences between the claimed subject matter and the prior art as well as the high level of skill in the art.

There is certainly no explicit motivation, teaching, or suggestion to combine the references, and the Examiner correctly does not cite to any. In *KSR*, the Supreme Court discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, and motivation test. The operative question in this “functional approach” is thus “*whether the improvement is more than the predictable use of prior art elements according to their established functions*” (emphasis added).

Furthermore, to facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Here, there is no reason whatsoever, why Mukaiyama cures the defects of Vidyanand. Furthermore, there is an absolute absence of any articulated reasoning with some rational underpinning to support the Examiner’s ad hoc rejection. The simple allegation that Mukaiyama teaches use of computers in business is so simplistic as to be a non sequitur. Under KSR, where the combination yields unpredictable results, the combination is patentable. Here, the invention extends beyond simply adding a computer to a way of doing business, and relates to automation and dynamic matching of business to business processes. While it may be ‘obvious’ to use a computer for dynamic matching of business to business processes, the manner and fashion of using that computer is the subject of these claims, and attempting to resolve the differences between Vidyanand by arguing it obvious to use a computer does not result in a prima facie case of obviousness. Similarly, these claims are not a simple substitution of a known element for another.

Therefore, neither independent claims 1, 8, and 15 nor claims 2-7, 9-14, and 16-17 depending from claim 1, 8, or 15 respectively, are obvious over Vidyannand in view of Mukaiyama.

Withdrawal of the rejections to claims 1-17 is requested.

CONCLUSION

The Applicants respectfully submit that claims 1-18 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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